

REMARKS

Claims 1-43 are pending. Entry of the amendment is respectfully requested. No new matter has been added. Support for the amendment can be found in the original claims and specification. Reconsideration is respectfully requested.

Status of the claims

Claims 1-4, 6, 8, 12-15, 17, 19, 22-25, 29-32, 34, and 36-41 were objected to because of minor informalities.

Claims 1-43 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-2, 6, and 17-19 were rejected under 35 U.S.C. § 103(a) based on Nama (US 4,991,008) in view of Shiota (US 6,337,712) and Java Goes Full Circle (“Java”).

Claims 3, 8-10, 14, 20, and 22 were rejected under 35 U.S.C. § 103(a) based on Nama in view of Shiota, Java, and Hackett (US 5,926,210).

Claims 11-12, 15, 21, 23-24, and 42-43 were rejected under 35 U.S.C. § 103(a) based on Nama in view of Shiota, Java, Hackett, and Official Notice.

Claims 5 and 13 were rejected under 35 U.S.C. § 103(a) based on Nama in view of Shiota, Java, Hackett, and Hoang (US 6,014,183).

Claim 16 was rejected under 35 U.S.C. § 103(a) based on Nama in view of Shiota, Java, Hackett, Hoang, and Official Notice.

Claims 4, 7, 30-32, and 38-41 were rejected under 35 U.S.C. § 103(a) based on Nama in view of Shiota, Java, and Official Notice.

Claims 33-37 were rejected under 35 U.S.C. § 103(a) based on Nama in view of Shiota, Java, Official Notice, and Hoang.

Claims 25-27 were rejected under 35 U.S.C. § 103(a) based on Nama in view of Shiota, Java, and Kadono (US 5,010,238).

Claims 28-29 were rejected under 35 U.S.C. § 103(a) based on Nama in view of Shiota, Java, Kadono, and Houvener (US 6,202,055).

The minor claim objections

The claims have been amended as requested by the Office. Withdrawal of the claim objections is respectfully requested.

The 35 U.S.C. § 112, second paragraph, rejections

Claims 1-40

Claims 1-40 have been amended as requested by the Office. Applicants respectfully submit that these claims are not indefinite. Thus, withdrawal of the 35 U.S.C. § 112, second paragraph, rejections regarding claims 1-40 is respectfully requested.

Claims 41-43

With regard to claim 41, the Action indicates that the claim has “a plurality of transaction function devices” followed by “at least one transaction function device”. As best understood, the Action suggests using language like “at least one of said plurality of transaction function devices” instead of the recited “at least one transaction function device”. The Applicants respectfully decline the suggestion.

The reason for the claim 41 “rejection” is unclear. Claim 41 recites that the ATM has a plurality of “transaction function devices” and that an ATM transaction function can be carried out “through operation of at least one transaction function device”. Thus, there is proper antecedent basis, and the claim language would not be considered “indefinite” to those skilled in the ATM art.

As best understood, the Action also suggests using language like “the image data corresponding to the signals” instead of the recited “the image data”. The Applicants also respectfully decline this suggestion.

The reason for this claim 41 “rejection” is also unclear. Claim 41 recites “image data corresponding to the signals” and later refers back to “the image data”. Thus, there is proper antecedent basis, and the claim language is not “indefinite”.

Applicants respectfully submit that claims 41-43 are not indefinite. Thus, withdrawal of the 35 U.S.C. § 112, second paragraph, rejections regarding claims 41-43 is respectfully requested.

The 35 U.S.C. § 103 rejections

Applicants respectfully disagree with the rejections. Nevertheless, claims have been amended to advance prosecution.

Claim 1

The Action admits (on page 12, last paragraph) that Nama does not teach or suggest storing image data corresponding to camera signals in a data store in response to an automated banking machine carrying out a transaction function. Applicants respectfully submit that Nama is absent more of the recited features than the Office acknowledges. For example, Applicants respectfully submit that Nama also does not teach or suggest selectively storing (in a data store), based upon the type of user transaction, images of automated banking machine users. As best understood, Nama appears to store all images, regardless of transaction type. Nama is not directed to “selective storage of images” “based on transaction type”.

Shiota cannot alleviate the admitted and other noted deficiencies in Nama. Shiota (like Nama) does not teach or suggest selectively storing (in a data store) images of automated banking machine users based upon type of user transaction. Shiota is not even directed to

storage of images of users involved in a transaction at a cash dispensing automated banking machine. Shiota is non analogous art. Shiota is directed to transfer of memory data from a *personal* digital camera to a server via a coin-operated machine (15) that includes a card reader, interface cable, docking station, and infrared beam receiver. The arrangement allows the memory data that was sent to the server to be later accessed and utilized. Shiota indicates that the coin-operated machine should be easily usable for self service. Shiota gives examples of types of well known easily usable (publically available) self service machines, including a vending machine, an ATM at a bank, and a fax machine at a convenience store. That is, Shiota merely mentions an “ATM” in giving an example of a easily usable self service machine. Shiota does not teach or suggest using an ATM for transferring memory data from a personal digital camera to a server, as apparently alleged by the Office (and apparently relied upon in the rejection).

The rejection also relies on JAVA for teaching “Java-enabled browsers on ATMs” to access data via the Internet. It is unclear how this relied upon JAVA teaching relates to the recited invention, Nama, or Shiota. Claim 1 is not directed to using an ATM browser to *access* data via the Internet. Claim 1 is directed to using a user terminal (not an ATM) to *access* images of a machine user from a data store, where “the user terminal is *remotely located* from the machine”. JAVA (like Shiota) cannot alleviate the admitted and other noted deficiencies in Nama.

The relied upon references to Nama, Shiota, and Java, whether taken alone or in combination, do not teach or suggest to one of ordinary skill in the art at the time of Applicants’ invention, selectively storing (in a data store) images of machine users (of a cash dispensing automated banking machine) based upon the user’s selected type of transaction, where images of

machine users involved in one selected type of transaction are stored but images of machine users involved in a different selected type of transaction are not stored. The references do not base whether a machine user image should be stored on the type of transaction requested by the user. The references do not link storage of a user's image to that user's type of transaction. In the references, user image storage is not selectively dependent on user transaction type.

The references also do not teach or suggest the recited features and relationships regarding an automated banking machine, camera, computer, server, communication network, user terminal, browser, and display device. The Office has not established a *prima facie* case of obviousness. The record is also absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have combined the references, especially to have produced the recited invention. Rather, the attempt to combine the alleged teachings is clearly an attempt at hindsight reconstruction of Applicants' claimed invention, which attempt is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Applicants' disclosure. Thus, the rejection should be withdrawn.

Claim 38

For reasons already discussed with regard to Applicants' claim 1 remarks, the references also do not render obvious claim 38. The references do not teach or suggest to one of ordinary skill in the art at the time of Applicants' invention, selectively storing (in a data store) human image data, where human image data corresponding to camera signals produced during an ATM transaction are stored in response to operation of a particular ATM function device but human image data corresponding to other ATM transactions not involving operation of the particular

function device are not stored.

The “Official Notice” is only directed to an allegation that “automated banking machines commonly have a plurality of transaction function devices”. Thus, the addition of this “Official Notice” cannot alleviate the many previously noted deficiencies in Nama, Shiota, and Java.

The Office has not established a *prima facie* case of obviousness. The record is also absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have combined the references, especially to have produced the recited invention.

Claim 41

The Action indicates that claim 41 is rejected under the same evidence and logic as claim 38. Thus, the Office has again failed to establish a *prima facie* case of obviousness. The record is again absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have combined the references, especially to have produced the recited invention.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. Applicants have shown the independent claims to be allowable. Thus, the dependent claims are allowable on the same basis. Furthermore, each dependent claim recites additional features and relationships that further patentably distinguish these claims from the applied references.

The Rejections Are Legally Improper

The rejections are based on features improperly attributed to references

The 35 U.S.C. § 103(a) rejections are further faulty because, in contrast to an understanding of the references by a person having ordinary skill in the art at the time of the present invention, it is based on (the Office) improperly attributing features to the references which are neither taught nor suggested thereby.

The applicable legal standard for “obviousness” has not been met by the Office

Applicants respectfully submit that the 35 U.S.C. § 103(a) rejections are also legally improper because the required legal criteria for establishing “obviousness” has not been met by the Office. In order to present a valid rejection based on obviousness, it is first necessary for the Office to make a *prima facie* showing of obviousness. *Prima facie* obviousness requires a showing that each of the recited features and relationships in the claims was known in the prior art. If the Office fails to establish a *prima facie* case of obviousness (which is the current situation), then Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Even in cases where the Office has established a *prima facie* showing of obviousness, a rejection cannot be properly made unless there is a requisite showing that it would have been obvious to one having ordinary skill in the art at the time the invention was made, to have combined features and relationships to have produced (at that time) the invention as claimed. In accordance with the dictates of the United States Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), the determination as to whether there is a reason to combine prior art features must be evaluated through an analysis of the factors recited in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries that must be made under *Graham* include:

- (a) determining the scope and content of the prior art,
- (b) ascertaining the differences between the prior art and the claims in issue,
- (c) resolving the level of ordinary skill in the pertinent art, and
- (d) evaluating evidence of secondary consideration.

The Action fails to present a proper *Graham* analysis

In accordance with the requirements of *Graham*, it is mandatory that before a claim can be rejected on the basis of obviousness, the Office is required to make a factual determination and resolve the level of ordinary skill in the pertinent art which existed at the time Applicants' invention was made. MPEP § 2141(2)(C). It is respectfully submitted that the Action does not include such a full determination. That is, there is no evidence of record that the level of one of ordinary skill in the art at the time of Applicants' invention has been resolved by the Office. Nor has the record established the Examiner to be a person of ordinary skill in the art at the time of Applicants' invention.

The rejection is not based on one of ordinary skill in the art at the time of the present invention

The 35 U.S.C. § 103(a) rejections are also faulty because they do not correctly apply the level of ordinary skill in the art at the *time of the present invention* (October 9, 1998). Rather, the Office improperly applied a "2008" level of ordinary skill in the art instead of a "1998" level of ordinary skill in the art.

The record shows that the reasons for combining features of the references in the rejections are based on the opinion of the Examiner. Thus, it must be concluded that the basis for combining features of the cited references in the rejection is *not* based on the opinion of a person of ordinary skill in the art at the time of the present invention. That is, the alleged reasons for combining features of the cited references are at best based on the mere opinion of the Examiner, which opinion is entitled no evidentiary weight because the Examiner is *not* a person of ordinary skill in the art at the time of the present invention. For this additional reason, Applicants respectfully submit that the rejections are legally improper and should be withdrawn.

The Declarations pursuant to 37 C.F.R. § 1.132

A declaration under 37 C.F.R. § 1.132 is submitted herewith. The declaration is from a person with actual knowledge of the relevant art and the level of ordinary skill in the art at the time of the present invention. The declaration further establishes that the relied upon references do not provide any teaching, suggestion, motivation, or valid reason to a person of ordinary skill in the art at the time of the present invention to have produced the recited invention. That is, the declaration provides further evidence that the recited subject matter, in full view of the applied references, would *not* have been obvious to a person of ordinary skill in the art at the time of Applicants' invention.

It is well settled that "weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him." *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967). Applicants respectfully submit that the declaration provides such statement. Thus, the declaration refutes the 35 U.S.C. § 103(a) rejections.

Conclusion

Applicants respectfully submit that this application is in condition for allowance. The undersigned is willing to discuss any aspect of this application at the Office's convenience.

Respectfully submitted,



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